

**AMENDMENTS TO THE DRAWINGS**

The attached sheet of drawing include changes to Fig. (3a-3b). The sheet, which includes Fig. (3a-3b), replaces sheet the original including Fig. (3a-3b).

Attachment: Replacement Sheet(s) (1)

**REMARKS**

Claims 1-7 are all the claims pending in the application.

Claims 1 -7 are rejected.

The specification is objected by the Examiner

The Drawings filed on March 13, 2007 are objected by the Examiner

Claims 4-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2000-116105 (JP '105).

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Korenaga et al. (US 6,037,680).

Claims 2-4 are rejected under U.S.C. 103(a) as being unpatentable over Korenaga in view of JP 2000-308328.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Korenaga and JP 2000-308328, in view of Tsuboi et al. US 2001/0048249.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Korenaga in view of Hwang et al. (US 6,528,907).

The Applicants traverse the rejections and request reconsideration.

***Drawings***

The Applicants respectfully submit revised drawings with Fig.3(a) – Fig. 3(b) marked “prior art” as required by the Examiner.

***Specification***

The Examiner has objected to the Specification for various informalities. The informalities noted by the Examiner have been corrected. Thus, withdrawal of this objection is respectfully requested.

***Claim Rejections Under 35 U.S.C. § 112***

**Rejection of claims 4-5 under 35 U.S.C. 112**

The Applicant's respectfully propose amending claims 4 and 5 to depend from claim 3 as these claims appear to further limit elements that were first presented in claim 3.

***Claim Rejections Under 35 U.S.C. § 102***

**Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2000-116105 (JP '105).**

The present invention, as recited in claim 1, requires a stator with a stator base. An armature with a magnetic iron core is fixed on the stator base. An armature winding (item 32 of the exemplary embodiment shown below) is wound around the magnetic iron core 33.

FIG. 2

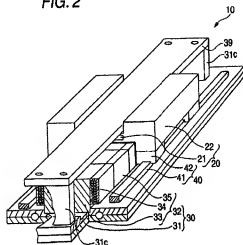
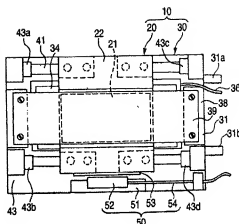


FIG. 1 (a)



A movable body 20 has a field permanent magnet 21. A magnetic holder 20 made of a non-magnetic substance supports the field permanent magnet. A magnetic back yoke 39 is arranged on the side opposite to the armature with respect to the field permanent magnet. **Importantly, as shown in the figure above, the width of the magnetic back yoke is approximately equal to a width of the field permanent magnet.**

JP '105 relates to a linear actuator. The Examiner reads the magnetic holder on item 40, shown in Fig. 12 of JP '105. While the frame 40 of JP '105 appears to hold the permanent magnet, there does not appear to be any disclosure that this is made of non-magnetic material, as required by the present invention. The Examiner appears to contend that this feature is inherent.

However, the Examiner is believed to be mischaracterizing the law of inherency. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. MPEP 2112.IV *citing In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) and *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the

reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Id. citing In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

More importantly, the Examiner reads the back yoke on the "left and right parts" of Fig. 2 (see, ¶ 8 of the office action). A review of JP '105 indicates that the Examiner could only be referring to the outer yoke 3 shown in Figs 1-3. However, the outer yoke 3 appears to be much broader than the permanent magnet. As noted above, the present invention (as recited in claim 1) requires the **magnetic back yoke to be approximately equal to the width of the field permanent magnet**.

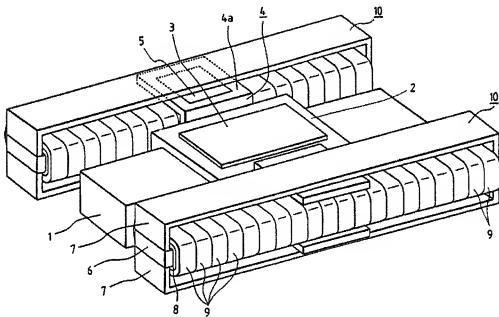
"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131 *citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Id. citing Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *Id. citing In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Claim 1 is not anticipated by JP '105 at least because it does not disclose a magnetic holder made of a non-magnetic material and does not disclose that the magnetic back yoke to have a width approximately equal to that of the field permanent magnet

Claim 7 is dependent on claim 1 and is allowable at least for the same reasons.

Rejection of claim 1 as being anticipated by Korenaga et al. (US 6,037,680).

As with JP '105, there is no explicit disclosure that the magnetic holder 4 of Korenaga is made of a non-magnetic material. Notwithstanding the Examiner's assertions to the contrary, it cannot be inherent that the holder 4 be made of non-magnetic material.

*FIG. 1*



***Claim Rejections Under 35 U.S.C. 103***

**Rejection of claims 2-4 as being unpatentable over Korenaga in view of JP 2000-308328**

Claims 2-4 are dependent on claim 1, and are patentable at least for the same reasons.

JP '328 is cited for its alleged teaching related to the linear scale being fixed on the holder. The Applicants respectfully submit that while the Examiner appears to be referring to JP '328, the item numbers that the Examiner cites are not present in JP '328. In fact, they appear to

refer to Fig. 3 of the present Specification, which the Applicants admit to be prior art. Moreover, the Applicants are unable to find any linear guides or linear scales in JP '328.

The Examiner is requested to clearly specify as to which prior art he is referring to in making the section 103 rejections referred to above.

Referring to the admitted prior art of Fig. 3, the Applicants respectfully submit that the linear scale is positioned on the yoke. However, claim 2 requires the linear scale to be on the magnetic holder which in turn is made of non-magnetic material. On the other hand, in rejecting claim 2 based on the combined teachings of Korenaga and JP '328, the Examiner appears to be considering the yoke itself as the magnetic holder. However, this is believed to be inconsistent because, the yoke is required to be stationary and the magnetic holder is with the movable part.

Rejection of Claim 5 based on Korenaga and JP 2000-308328, in view of Tsuboi et al. US 2001/0048249.

Claim 5 is dependent on claim 1. Therefore, it is allowable for at least the same reasons.

Rejection of claim 6 based on Korenaga in view of Hwang et al. (US 6,528,907).

Claim 6 is dependent on claim 1. Therefore, is allowable for at least the same reasons.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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